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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,046	10/17/2001	Joseph G. Barrett	06975-132002	3693
26171	7590	08/25/2005	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EDELMAN, BRADLEY E	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/978,046

Applicant(s)

BARRETT ET AL.

Examiner

Bradley Edelman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-69 and 75-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15, 16, 31, 34-47, 51, 52 and 75-82 is/are rejected.
- 7) ☒ Claim(s) 12-14, 17-30, 32, 33, 48-50 and 53-69 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/10/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This Office action is in response to Applicant's amendment and arguments filed on May 10, 2005. Claims 1-69 and 75-82 are presented for examination. Claims 75-82 are new claims.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 76 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In considering claim 76, the term "the sender identifier" on line 3 of the claim lacks sufficient antecedent basis and is therefore ambiguous. For the purposes of examination, Examiner will interpret the phrase as meaning "a sender identifier."

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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1. Claims 1, 2, 5-7, 10, 11, 15, 16, 31, 34, 35, 38-40, 45-47, 51, and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Holmes et al. (U.S. Patent No. 6,134,432, hereinafter "Holmes").

In considering claim 1, Holmes discloses a method for communicating electronic data in a manner that identifies the sender, including:

Receiving electronic data ("reply") from an intermediary ("gateway") located between a sender and an intended recipient of the electronic data, identifying the sender at the intermediary ("MSISDN number is sent with the reply"), changing the electronic data to include a sender identifier based on the identifying performed at the intermediary (col. 5, lines 7-12, "map [the MSISDN number] back onto the e-mail address of the original sender"), and forwarding the changed electronic data to the intended recipient (col. 5, lines 7-15).

In considering claim 2, Holmes further discloses that the sender is not a host (i.e. the sender is just a regular e-mail sender).

In considering claim 5, Holmes further discloses that sender identifier comprises a screen name ("internet mail address," col. 5, line 11).

In considering claim 6, Holmes further discloses that sender identifier comprises account information ("internet mail address," col. 5, line 11).

In considering claim 7, Holmes further discloses that sender identifier comprises information identifying a person (i.e. "internet mail address," which identifies the mail user.

In considering claim 10, Holmes further discloses that the electronic data is e-mail.

In considering claim 11, Holmes further discloses that identifying the sender comprises determining an address from which the electronic data is received (i.e. MSISDN number) and determining the sender identifier based on the address from which the electronic data is received (i.e. the gateway maps the MSISDN number to the e-mail address of the original sender, col. 5, lines 7-12).

In considering claim 15, Holmes further discloses that changing the electronic data comprises appending to the electronic data the sender identifier, and forwarding the changed electronic data comprises forwarding the electronic data along with the appended sender identifier (i.e. e-mail address of the original sender, col. 5, lines 7-12).

In considering claim 16, Holmes further discloses that appending the sender identifier includes appending the sender identifier as a header to the electronic data (the address will necessarily be appended to the header so that the message can be properly routed).

In considering claim 31, Holmes further discloses that identifying the sender includes identifying an initial source that generated the electronic data (i.e. identifying the mobile device as the source).

Claims 34-35, 38-40, 46-47 and 51-52 contain a computer readable medium for performing the same method described in respective claims 1-2, 5-7, 10-11, and 15-16.

Claim 45 contains the same limitations as claim 47, except it specifies that the address from which the electronic data is received is not an IP address. Holmes further discloses such a feature (i.e. the address is a MSISDN number, which is not an IP address).

2. Claims 75-77, 79-82 and 1, 2, 5-7, 11, 34, 35, and 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Gabber et al. (U.S. Patent No. 6,591,291, hereinafter "Gabber").

In considering claim 75, Gabber discloses a method for communicating electronic data in a manner that identifies a sender, the method comprising:

Receiving electronic data at an intermediary ("filter") located between a sender and an intended recipient of the electronic data (col. 6, lines 1-2);

Identifying the sender at the intermediary (col. 6, lines 27-35, "alias source address is compared...");

Changing the electronic data to identify the sender based on the identifying performed at the intermediary (col. 6, lines 40-47, "sender's real source address is derived"); and

Forwarding at least a selected portion of the changed electronic data to the intended recipient (col. 6, lines 48-50, "reply e-mail is forwarded to the sender").

In considering claim 76, as understood, Gabber further discloses determining an address from which the electronic data is received (i.e. the recipient address), and determining a sender identifier based on the address from which the electronic data is received (i.e. the alias source address is used to determine the sender source address, col. 8, lines 28-50).

In considering claim 77, Gabber further discloses that changing the electronic data to identify the sender based on the identifying performed at the intermediary comprises adding a sender identifier to the electronic data (col. 8, lines 44-47, "real source address... [is] substituted into the reply e-mail for the alias source address").

In considering claim 79, Gabber further discloses that the sender identifier is an online identifier (i.e. e-mail address).

In considering claim 80, Gabber further discloses that the sender identifier is an screen name (i.e. e-mail address).

In considering claim 81, Gabber further discloses that the sender identifier is account information (i.e. e-mail address).

In considering claim 82, Gabber further discloses that the sender identifier is information identifying a person (i.e. e-mail address).

In considering claims 1, 2, 5-7, 11, 34, 35, and 38-40 contain essentially the same limitations already disclosed with regard to claims 75, 76, and 78-82 and are disclosed in the same cited sections of Gabber.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3-4, 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes.

In considering claims 3 and 36, Holmes discloses that the sender identifier comprises "either an Internet mail address or some other type of client ID" (col. 5, lines 11-12). However, Holmes does not disclose that the "other type of client ID" is necessarily an IP address. Nonetheless, Holmes does disclose that the clients in the



system have IP addresses (col. 3, lines 55-60) and such IP addresses uniquely identify client computers. Thus, given this knowledge, it would have been obvious for the "other type of client ID" taught by Holmes to be an IP address because IP addresses are a simple way to uniquely identify client computers.

In considering claims 4 and 37, Holmes further discloses that the sender identifier can be more than an IP address (i.e. an e-mail address is more than an IP address).

4. Claim 78 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gabber, in view of Holmes.

In considering claim 78, Gabber discloses that the source sender identifier comprises an e-mail address, and not an IP address. However, as discussed above, Holmes discloses that IP addresses are also used as source addresses. Thus, it would have been obvious to convert the IP address in the Gabber system rather than the e-mail address because IP addresses are a simple way to uniquely identify computers, thereby ensuring consistent and secure message filtering in a network.

5. Claims 8, 9, and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes, in view of Venkatachary et al. (U.S. Patent No. 6,212,184, hereinafter "Venkatachary").

In considering claims 8, 41, 43, and 44, although the system taught by Holmes discloses substantial features of the claimed invention, it does not describe that the intermediary or its components comprise a layer 4 redirection program. Nonetheless, it would be desirable to implement the redirection program on the lowest layer possible, because processing at a lower layer will take less time than processing at the application layer. Furthermore, the use of layer 4 redirection in an e-mail message forwarding system is well known, as evidenced by Venkatachary (see col. 6, lines 42-60, and col. 6, lines 16-49, giving an overview of the layer 4 message forwarding system). Thus, it would have been obvious to a person having ordinary skill in the art to use layer 4 redirection for the message forwarding system taught by Holmes, in order to provide a faster message processing system.

In considering claims 9 and 42, the layer 4 redirection system taught by Venkatachary further identifies senders based on the data packets examined (col. 6, lines 32-41; col. 8, lines 38-49, describing examining the packet for different fields, including a source address).

### ***Response to Arguments***

Applicant's arguments filed on May 10, 2005 have been fully considered, but are considered moot in view of the new grounds of rejection. Note that the claim amendments overcame the Paul reference, which disclosed adding the word "JUNK" to messages based on a sender identification. Because the present claims describe

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adding a "sender identifier" to the messages, this overcomes the Paul disclosure of merely adding the word "JUNK" which can at best be considered a sender *category* or *type* identifier, rather than an actual sender identifier.

### ***Allowable Subject Matter***

Claims 12-14, 17-30, 32-33, 48-50, and 53-69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

These claims contain allowable subject matter because the specific limitations in each claim are not disclosed or suggested in the prior art of record.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 571-272-3953. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached at 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BE

August 18, 2005

A handwritten signature in black ink, reading "Bradley Edehuan". The signature is written in a cursive, flowing style with a long horizontal stroke at the end.